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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,459

02/20/2004

Albert Boeckh

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7475

7590 08/29/2008  
JUDY JARECKI-BLACK, PH.D., J.D.  
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EXAMINER

LEVY, NEIL S

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

08/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,459	<b>Applicant(s)</b> BOECKH ET AL.	
	<b>Examiner</b> NEIL LEVY	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 23, 24, 28 and 46-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 23, 24, 28 and 46-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11, 23, 24, 28 and 46-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/15/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The finality of the rejection of the last Office action is withdrawn.

See the new rejection following an updated search.

The text of those sections of Title 35, U.S. Code not included in this action can be found  
in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

abbreviations should be spelled out at first appearance in claims.

#### ***Claim Rejections - 35 USC § 103***

Claim 1-11, 23, 24, 28, and 46-57 are  
rejected under 35 U.S.C. 103(a) as being unpatentable over LAMM WO 03/015519 in  
view of HUET et al 64842425 and TENG- '93

LAMM provides compositions of animal health (page 1, line 12) of aryl pyrazole derivatives )I, page 1) and the derivative fipronil as at least one of (claim 13) a few added actives including amitraz. Formulations include solutions, suspensions, emulsions and gels (page 51) with (page 51, line 10) surfactants inclusive of polyethoxylated sorbitan esters of instant claims 10 & 11. Carriers/solvents include water and methanol, propylene glycol, DMSO, dimethyl formamide, & benzyl alcohol

Art Unit: 1615

(p. 52) prepared by mixing (p. 52, lines 22,23).

Spraying application is preferred (page 61, line 34) but topical application is also envisioned (page 62, top) the carriers and surfactants at pages 51 and 52 providing suitable agents for these formulations.

HUET provides the instant topical compositions inclusive of LAMM carrier, solvents and surfactants (column 6, line 51) and water, methanol, equivalently ethanol, dimethylformamide, equivalently transcitol, and sorbitan esters (claim 1, column 7, lines 4-57). The instant crystallization inhibitors, advantageous for topical application (column 7, bottom) is also shown by HUET at 1-20%, column 6; column 8, bottom) as are the instant BHA and BHT antioxidants (column 8, lines 4-8). Preparation is by mixing (column 8, lines 9-13).

There is no distinction between pour on and spot on, in the claimed instant compositions. The preferred compounds of LAMM include amitraz, abamectin, and fipronil and a dozen others. The HUET compositions favor abamectin with fipronil.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize pest control means, For the artisan to combine LAMM's preferred mixes, leading to combinations of LAMM's actives mixed with fipronil and amitraz, as one formulation. HUET shows advantageous use of fipronil combinations, to control fleas, ticks (column 1, column 2, lines 8-12), thus the motivation to select fipronil in particular as one of the added actives. Additionally, adding amitraz

Art Unit: 1615

extends control to mites, as shown by TENG (abstract) & would provide an increased range of species controlled, Thus the formulation would be

modified to increase the range of species controlled in one formulation of compatible ingredients for application to the locus of animal health pests.

All the critical elements of the instant are disclosed. The amounts and proportions of each ingredient are result effective parameters chosen to obtain the desired effects.

Selection & testing of the small number of added actives of the Lamm invention would be well within the purview of the artisan , with expectation of success in controlling pests, particularly given the direction of Huet & Teng, in consideration of the 2007 supreme court decision in *KSR V TELEFLEX* @ 82 USPQ 2d @ 1385.

It would be obvious to vary the form of each ingredient to optimize the effect desired, depending upon the particular species and application method of interest, reduction of toxicity, cost minimization, enhanced, and prolonged, or synergistic effects.

Applicant has not provided any objective evidence of criticality, nonobvious or unexpected results that the administration of the particular ingredients' or concentrations provides any greater or different level of prior art expectation as claimed, and the use of ingredient for the functionality for which they are known to be used is not basis for patentability.

Art Unit: 1615

Claims 1, 23, and 28 drawn to the selected crystallization inhibitor, transcutool and ethanol with actives consisting of only fipronil and amitraz would be non obvious over the art of record. Amitraz and fipronil are well known to be formulated together.

Claims 8, 9, 10, 11, and 23 are optional inhibitors; they are not required

Amitraz and fipronil are well known to be formulated together. However, claims 1, 23, and 28 drawn to the elected crystallization inhibitor, transcutool and ethanol with actives consisting of only fipronil and amitraz would be non obvious over the art of record. Note that Claims 8, 9, 10, 11, and 23 are optional inhibitors; they are not required in the language currently claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NEIL LEVY/  
Primary Examiner, Art Unit 1615